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10/630,532

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12/09/2009

EXAMINER

LONG, FONYA M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/630,532	Applicant(s) MORRIS, DANIEL R.	
	Examiner FONYA LONG	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/03/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a Non-Final Office Action rejection on the merits in response to communications received on August 10, 2009. Claims 1, 10, 19, 21, 23, and 30 have been amended. Claims 1-31 are currently pending and have been addressed below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-9, 19, and 20, as clarified in Bilski, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

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As per Claims 1-9, 19, and 20, the claims fail to recite a particular machine or apparatus being tied to the claimed method steps. Rather, the claims merely recite method steps that can be performed manually by a human being without the use of a machine or apparatus. The claims also fail to recite a transformation of a particular article to a different state or thing. The claims are directed to searching and tracking lien record and providing reports.

As per Claims 10-18, 21, and 22, the claims are rejection under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because they are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory, a computer program must be coupled with or combined with some statutory physical structure.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg et al. (US 2002/0107703) in view of MERS® Integration Handbook (Vol. II, Version 11.0, May 19, 2002).

As per Claims 1 and 10, Feinberg discloses a method and system for managing lien releases, comprising the steps of:

providing access to lien records for a plurality of lien-record jurisdictions, each of said lien records including a respective lien holder entry ([0005] via once the service provider receives payment, it is necessary to file a satisfaction or release of the lien. A release or satisfaction is prepared with the recording number and other certain information required by law or rule, again often on a specialized form which may differ from jurisdiction to jurisdiction. The release is submitted to the proper agency and recorded.);

identifying at least one lien where the note underlying the at least one lien has been satisfied ([0016] via receiving notice that payment has been received and preparing a release of a lien from the patient and insurance data previously transmitted and stored when the lien was originally prepared); searching lien records and determining from the lien records whether the at least one lien is due for release as a result of the note having been satisfied ([0016] via retrieving from the database (i.e. searching) patient and insurance data in regards to a lien that was filed and preparing a release based on the guidelines form each jurisdiction previously stored on the database. Examiner asserts that it is implied that if the guidelines cannot be met then it is determined that a release cannot be issued.);

identifying whether at least one lien holder is subject to an action for non-release of a real-property-related lien ([0016] via retrieving from the database (i.e. searching) patient and insurance data in regards to a lien that was filed and preparing a release

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based on the guidelines form each jurisdiction previously stored on the database.

Examiner asserts that it is implied that if the guidelines cannot be met then a release is not issued.); and

repeating steps (b) and (c) at given time intervals ([0016] discloses the steps of determining a release of a lien to be repeated each time a notice of proper payment is received).

Feinberg discloses the invention being applicable to various types of liens such as commercial and residential construction (i.e. real property) ([0017]). However, Feinberg fails to explicitly disclose presenting a report of a subset of said lien records.

MERS® Integration Handbook teaches several different reports which present a report of a subset of liens due for release and those subject to action to penalty for non-release (MERS® Integration Handbook, Appendix D, Page 104 via Assignment and Lien Releases Report and Page 108 via Payoff Reject Report).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include presenting a report of a subset of said lien records as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claims 2 and 11, Feinberg discloses the claimed invention as applied to Claims 1 and 10, above. However, Feinberg fails to explicitly disclose presenting a report upon receiving a request.

MERS® Integration Handbook teaches several different reports wherein a user may request and receive a report via the MERS® OnLine browser application (Page 12).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include presenting a report upon receiving a request as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claims 3 and 12, Feinberg discloses the claimed invention as applied to Claims 1 and 10, above. However, Feinberg fails to explicitly disclose presenting a report operable upon detection of a change in said identified liens or lien holders.

MERS® Integration Handbook teaches several different reports wherein a report may be presented upon detection of a change in said identified liens or lien holders (Page 12, via daily-activity based reports and confirmation reports are generated. A user (whom may have detected a change in a lien) may request and receive a report via the MERS® OnLine browser application.).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include presenting a report operable upon detection of a change in said identified liens or lien holders as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claims 4 and 13, Feinberg discloses the claimed invention as applied to Claims 1 and 10, above. However, Feinberg fails to explicitly disclose identifying release liens.

MERS® Integration Handbook teaches several different reports wherein a report is generated that identifies all release liens (MERS® Integration Handbook, Appendix D, Page 104, via Assignment and Lien Release Report).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include identifying release liens as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claims 5 and 14, Feinberg discloses a database of jurisdictional-specific rules regarding lien releases ([0016] via the release is prepared according to guidelines from each jurisdiction previously stored on the database).

As per Claims 6 and 15, Feinberg discloses providing a database of documents associated with said rules ([0003-0004] discloses preparing liens in accordance with certain information required by law or rule, often on a specialized form wherein the lien documents are archived and stored).

As per Claims 7 and 16, Feinberg discloses providing real-time access to said plurality of jurisdictions at substantially the same time ([0016] via providing access to guidelines from each jurisdiction that are stored in a database).

As per Claims 8 and 17, Feinberg discloses said given intervals are established by individual request ([0015-0016] discloses the release process being performed at given intervals based on a client transmitting an e-mail message to the data processing server giving notice that the client has received proper payment for a given patient's services).

As per Claims 9 and 18, Feinberg discloses the method steps being controlled by a network-accessible server ([0011-0012] via a plurality of clients on remote nodes are linked to the data-processing server, by the Internet).

As per Claims 19 and 21, Feinberg discloses a method for managing lien releases, comprising the steps of:

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receiving transactional information related to at least one lien ([0011-0012] discloses the client preparing an electronic data file of information that is from the client via the Internet to the data processing server);

providing at least one electronic document based on said transactional information ([0013] via creating a medical lien from the data on the database wherein the content and format of the document are specified by the guidelines stored in the database);

determining whether a lien record associated with said at least one lien can be tracked electronically ([0006] discloses tracking liens. Examiner asserts a determination of a lien being capable of tracking is performed by actually tracking the lien.) and whether the at least one lien is due for release as a result of a note underlying the at least one lien having been satisfied ([0016] via receiving notice that payment has been received and preparing a release of a lien from the patient and insurance data previously transmitted and stored when the lien was originally prepared);

searching for said lien record; and receiving search results associated with said lien record ([0016] via retrieving from the database (i.e. searching) patient and insurance data in regards to a lien that was filed and preparing a release based on the guidelines form each jurisdiction previously stored on the database.).

However, Feinberg et al. fails to explicitly disclose presenting a report.

MERS® Integration Handbook teaches several different reports which present a report identifying a release status associated with said lien record (MERS® Integration Handbook, Appendix D, Page 104 via Assignment and Lien Releases Report).

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Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include presenting a report as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claims 20 and 22, Feinberg et al. discloses initiating communications to determine whether said lien has been released to at least one of: a payoff lender, a settlement agent, a courthouse, a third party title insurance underwriter ([0016] via providing communication in the form of a copy of the release to the liable party and patient).

As per Claims 23 and 30, Feinberg et al. discloses a method and system for brokering lien release information, comprising the steps of:

providing a network-accessible server ([0011-0012] via a plurality of clients on remote nodes are linked to the data-processing server, by the Internet) having access to lien record information for a plurality of lien record-keeping jurisdictions ([0012-0013] discloses accessing guidelines on how to properly file a lien in each given jurisdiction), said server further having access to a database of electronic documents associated with at least one lien status ([0004] discloses providing access to archived lien documents. Examiner asserts that the type of document being stored and accessed is considered

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non-functional descriptive material. The method of stored and accessing a document would be performed the same regardless of the type of document.);

providing at least one user interface capable of accessing said server for inputting identification and transaction information pertaining to at least one lien ([0011] via the client providing patient's identification information, patient's insurance information, type and location of the accident, etc...);

providing at least one user interface capable of accessing said server for requesting at least one search in connection with at least one lien ([0016] via retrieving from the database (i.e. searching) patient and insurance data in regards to a lien that was filed and preparing a release based on the guidelines form each jurisdiction previously stored on the database.).

Feinberg discloses the invention being applicable to various types of liens such as commercial and residential construction (i.e. real property) ([0017]). However, Feinberg et al. fails to explicitly disclose identifying a lien status based on transaction information and jurisdiction information associated with a lien; requesting a determination as to whether the at least one lien has been released; displaying status information related to a lien; and requesting the generation of at least one document.

MERS® Integration Handbook teaches several different reports with the concept of identifying a lien status based on transaction information and jurisdiction information associated with a lien (MERS® Integration Handbook, Appendix D, Page 104, via Assignment and Lien Release Report); requesting a determination as to whether the at least one lien has been released (Page 12, discloses a user may request and receive a

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report via the MERS® OnLine browser application, wherein a report Lien Release Report may be generated (MERS® Integration Handbook, Appendix D, Page 104)); displaying status information related to a lien MERS® Integration Handbook, Appendix D, Page 104, via "Assignment and Lien Releases Not Quality Reviewed Report" and "Assignment and Lien Releases Report"); and requesting the generation of at least one document in connection with at least one lien (Page 12, discloses a user may request and receive a report via the MERS® OnLine browser application.).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include identifying a lien status based on transaction information and jurisdiction information associated with a lien; requesting a determination as to whether the at least one lien has been released; displaying status information related to a lien; and requesting the generation of at least one document as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As per Claim 24 and 31, Feinberg et al. discloses providing at least one user interface capable of accessing said server for requesting notification of a change in status information pertaining to at least one lien (Claim 7, via notifying required parties that a release has been filed).

As per Claim 25, Feinberg et al. discloses lien record information includes at least one of title information, recording information, indexing information, and financial information ([0013] vial recording number and recording date).

As per Claim 26, Feinberg et al. discloses the claimed invention as applied to Claim 23, above. Examiner takes Official Notice that it is old and well known in the art to provide a date of payment when providing documentation of a payment in order to aid in maintaining record of all payments received. For example, bills provide a date as to when a payment previously made was received. In addition, medical insurance settlement forms provide a date as to when funds were distributed to the medical provider.

As per Claim 27, Feinberg et al. discloses lien jurisdiction information ([0012] via guidelines are compiled from statutes, regulations, and local practice for each locale. Examiner asserts it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the guidelines include any statutory time limits in order to be compliance with the applicable statutes when creating liens and performing lien releases.).

As per Claim 28, Feinberg et al. discloses lien identification information includes at least one of an obligor, a lien holder, a loan amount, a payee identifier, and a lien jurisdiction ([0011] via liable party's identification (i.e. obligor)).

As per Claim 29, Feinberg et al. discloses the claimed invention as applied to Claim 23, above. However, Feinberg et al. fails to explicitly disclose lien status information including at least one of pending payment, awaiting statutory limit expiration,

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queued for search, searched by title searcher, awaiting search results, awaiting settlement agency release, pending demand, released and disbursement archived.

MERS® Integration Handbook teaches several different reports with the concept of lien status information including at least one of pending payment, awaiting statutory limit expiration, queued for search, searched by title searcher, awaiting search results, awaiting settlement agency release, pending demand, released and disbursement archived (MERS® Integration Handbook, Appendix D, Page 104 via Assignment and Lien Releases Report which discloses lien release statuses such as foreclosure pending (i.e. pending demand) and payoff (i.e. released)).

Therefore, from the teaching of MERS® Integration Handbook, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for automated lien management of Feinberg to include lien status information including at least one of pending payment, awaiting statutory limit expiration, queued for search, searched by title searcher, awaiting search results, awaiting settlement agency release, pending demand, released and disbursement archived as taught by MERS® Integration Handbook in order to aid in tracking liens by presenting a report of a subset of liens which are due for release or subject to penalty, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

Applicant's arguments filed August 10, 2009 have been fully considered but they are not persuasive.

Examiner asserts that Applicant has failed to provide a response in the "Remarks" filed August 10, 2009 in regards to the 101 rejections set forth in the previous office action. Examiner asserts that the 101 rejections are still valid and have been stated in the rejection stated above.

With regards to Claims 1 and 10, Applicant argues that Feinberg fails to be directed to real-property related liens. Examiner respectfully disagrees. Examiner asserts that Feinberg discloses the invention being applicable to various types of liens such as commercial and residential construction (i.e. real property) ([0017]).

Applicant also argues that Feinberg fails to disclose determining "whether the at least one lien is due for release as a result of a note underlying the lien having been satisfied. Examiner respectfully disagrees. Examiner asserts that Feinberg discloses determining "whether the at least one lien is due for release as a result of a note underlying the lien having been satisfied ([0016] via retrieving from the database (i.e. searching) patient and insurance data in regards to a lien that was filed and preparing a release based on the guidelines form each jurisdiction previously stored on the database. Examiner asserts that it is implied that if the guidelines cannot be met then it is determined that a release cannot be issued.)

Applicant's arguments with respect to claim 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689